

## REMARKS

Applicants respectfully request reconsideration of the above-identified application. Claims 1-12, 14-24, 26 and 28-40 remain pending in the present application. Applicants acknowledge with appreciation that Claims 22-24, 26, 28-34, 36 and 37 are allowed, and that Claims 3, 6, 7, 11 and 21 contain allowable subject matter.

Claims 1, 2, 4, 5, 8-10, 12, 14-20, 35, 38, 39, and 40 were rejected in a March 25, 2004, Office Action (hereinafter "Office Action") under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,727,429 issued to Ueda (hereinafter "Ueda"). For at least the reasons that will be described in detail below, applicants believe that the claims as presently recited are allowable over the prior art.

### Claim Rejections Under 35 U.S.C. § 102

Claims 1, 2, 4, 5, 8-10, 12, 14-20, 35, 38, 39, and 40 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Ueda. Applicants respectfully traverse the rejection to these claims. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d. 1051, 1053 (Fed. Cir. 1987). Applicants respectfully assert that these claims recite combinations of features neither taught nor suggested by Ueda.

### Independent Claim 1

Claim 1 is directed to an outsole of an athletic boot. The outsole of Claim 1 includes an outsole body having a toe region and a heel region, a frame member secured to the outsole body, and a pair of adjustment members adjustably mounted on the frame member at either the toe region or the heel region of the outsole body. A portion of each adjustment member is adapted

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for engagement with a binding. The adjustment members are extendable in a selected amount away from the frame member.

The Office Action contends that Ueda discloses an athletic shoe that comprises an upper and an outsole body 18 with toe and heel regions, a frame (or base) member, shown by the dotted line and labeled by the Examiner in the reference, secured and embedded in the outsole, cleats 16, and a pair of adjustment members (or spacers) 150 mounted to the toe region and extendible away from said frame for engaging a binding member 12, as shown in Figures 1 and 2. The Office Action further contends that due to the broadness of the claim and lack of recited structural interaction between the adjustment members and binding, the claims read on the pedal binding of Ueda.

Applicants respectfully disagree with the Office Action's contention. As clearly shown in Figure 1, and described in detail at Col. 9, lines 33-39, the members 150 characterized in the Office Action as adjustment members are actually threaded fasteners 150 for coupling the cleat 16 to the sole 18 of the cyclist's shoe. As known in the art, such a connection must be rigid for sufficient force transfer from the rider to the pedal. Since a rigid connection is necessary during use, applicants assert that the fasteners 150 of Ueda are not adjustably mounted to a frame and are not extendible in a selected amount away from the frame, as recited in Claim 1, but instead are utilized to rigidly attach the cleat 16 to the shoe.

Additionally, applicants respectfully assert that the fasteners 150 of Ueda do not contact and are not capable of contacting any portion of the pedal when secured thereto. Please see Figure 2, where the fastener 150 located at the left side of the page does not contact or engage the pedal 20. Additionally, please see Figure 3, where both slots 148 that receive the fasteners 150 for coupling the cleat 16 to the sole 18 are aligned with large openings such that each fastener 150 does not contact or engage nor is capable of contacting or engaging a portion

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of the pedal 20 when the shoe is coupled to the pedal. Thus, applicants assert that Ueda fails to teach or suggest "a portion of each adjustment member being adapted for engagement with a binding," as recited in Claim 1.

It is clear from the foregoing that Ueda fails to teach or suggest the recited combination of features of Claim 1. Thus, applicants respectfully request withdrawal of the pending rejection under 35 U.S.C. § 102 with regard to Claim 1. Accordingly, applicants respectfully request withdrawal of the pending rejections under 35 U.S.C. § 102 of Claims 2, 4, 5, 8, and 9, which depend from allowable Claim 1.

Independent Claim 10

Claim 10 recites an outsole having "at least one spacer having a binding contact surface adapted to contact the binding, said spacer adjustably mounted to said base member for selective orthogonal adjustment relative to said frame member." Accordingly, for at least the same reasons as discussed above with respect to Claim 1, applicants' invention, as recited in Claim 10, is neither taught nor suggested by Ueda. Thus, applicants respectfully request that the pending rejection of Claim 10 under 35 U.S.C. § 102(b) be withdrawn.

Independent Claim 12

Claim 12 recites an athletic shoe having "an adjustment member having an engagement portion and a threaded portion threadably engaged with said threaded portion of said base member, said adjustment member being threadably adjustable relative to said base member so that said engagement portion of said adjustment member projects a selective amount away from said base member." Accordingly, for at least the same reason as discussed above with respect to Claim 1, applicants' invention, as recited in Claim 12, is neither taught nor suggested by Ueda. Thus, applicants respectfully request that the pending rejection of Claim 12 under 35 U.S.C. § 102(b) be withdrawn.

Independent Claim 14

Claim 14 recites an athletic boot having "an interface adjustment mechanism for adjusting the interface between said boot and the binding, said interface adjustment mechanism disposed within said outsole and having at least one adjustment member, said adjustment member being extendable in a selected amount away from said outsole." Accordingly, for at least the same reason as discussed above with respect to Claim 1, applicants' invention, as recited in Claim 14, is neither taught nor suggested by Ueda. Thus, applicants respectfully request that the pending rejection of Claim 14 under 35 U.S.C. § 102(b) be withdrawn. Accordingly, applicants respectfully request withdrawal of the pending rejections under 35 U.S.C. § 102(b) of Claims 15-20, which depend from allowable Claim 14.

Independent Claim 35

Claim 35 recites an athletic boot in combination with a binding, wherein the athletic boot includes "at least one interface adjustment member selectively securable to said outsole of said boot and having a binding interface surface that contacts the boot interface surface of said binding when said boot is coupled to said binding, said interface adjustment member being extendable in a selected amount away from said outsole of said boot." Accordingly, for at least the same reasons as discussed above with respect to Claim 1, applicants' invention, as recited in Claim 35, is neither taught nor suggested by Ueda. Thus, applicants respectfully request that the pending rejection of Claim 35 under 35 U.S.C. § 102(b) be withdrawn.

Independent Claim 38

Claim 38 recites an outsole having "at least one adjustment member adjustably mounted on said frame member, a portion of which is adapted for engagement with a binding, said adjustment member further including an engagement portion and a threaded portion, wherein said engagement portion has an engagement surface, said engagement surface including

apertures that are engageable with a driver tool for rotary adjustment, said adjustment member being extendible in a selected amount away from said frame member." Accordingly, for at least the same reasons as discussed above with respect to Claim 1, applicants' invention, as recited in Claim 38, is neither taught nor suggested by Ueda. Thus, applicants respectfully request that the pending rejection of Claim 38 under 35 U.S.C. § 102(b) be withdrawn.

Independent Claim 39

Claim 39 recites an outsole having "at least one adjustment member adjustably mounted to either said fore or said aft holding member, a portion of said adjustment member being adapted for engagement with a binding, said adjustment member being extendible in a selected amount away from said frame member." Accordingly, for at least the same reasons as discussed above with respect to Claim 1, applicants' invention, as recited in Claim 39, is neither taught nor suggested by Ueda. Thus, applicants respectfully request that the pending rejection of Claim 39 under 35 U.S.C. § 102(b) be withdrawn.

Independent Claim 40

Claim 40 recites an outsole having "at least one adjustment member adjustably mounted on said frame member, a portion of which is adapted for engagement with a binding, said adjustment member being extendible in a selected amount away from said frame member." Accordingly, for at least the same reasons as discussed above with respect to Claim 1, applicants' invention, as recited in Claim 40, is neither taught nor suggested by Ueda. Thus, applicants respectfully request that the pending rejection of Claim 40 under 35 U.S.C. § 102(b) be withdrawn.

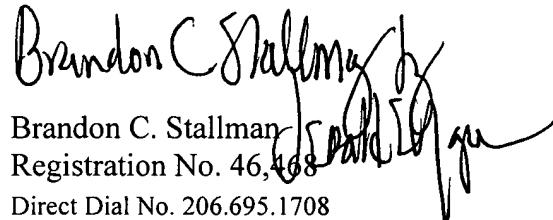
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## CONCLUSION

In light of the foregoing remarks, applicants assert that the claims of the present application recite combinations of features not suggested nor taught by the prior art. Therefore, applicants respectfully request early and favorable action and the allowance of all pending claims. If any further questions remain, the Examiner is invited to telephone applicants' attorney at the number listed below.

Respectfully submitted,

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Date: August 25, 2004

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